

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Gavin SHENKER et al.

Application No.: 10/826,092

Filed: April 16, 2004

Confirmation No.: 9257

Group Art Unit: 2876

Examiner: Seung H. Lee

For: A SYSTEM AND METHOD FOR MANAGING ELECTRONIC
DATA TRANSFER APPLICATIONS

RESPONSE TO OFFICE ACTION UNDER 37 C.F.R. §1.111

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This Response, together with a Petition for an Extension of Time, constitutes a reply to the Office Action mailed December 13, 2005 in the above-identified application. The following remarks and amendments are respectfully submitted.

Amendments to the Claims begin on page 2.

Remarks begin on page 13.

AMENDMENTS TO THE CLAIMS

1. (Currently Amended) A method for managing one or more data transfer applications on a mobile electronic device, the method comprising:
 - disabling all of the one or more data transfer applications on the electronic device;
 - identifying one or more of the data transfer applications which have been registered for use on the electronic device;
 - displaying an identifier for one or more of the registered data transfer applications on the electronic device;
 - receiving, from a user of the electronic device, a selection for one of the data transfer applications;
 - enabling the selected data transfer application for use by the user when the user satisfies an authentication mechanism ~~associated with~~ that is independent of the selected data transfer application; and
 - disabling the selected data transfer application.
2. (Cancelled)
3. (Previously Presented) The method of claim 1 wherein the authentication mechanism comprises entry by the user of a first authentication code which is compared to a second authentication code for the data transfer application.
4. (Original) The method of claim 1 wherein the authentication mechanism comprises the entry of a first personal identification number which is compared to a second personal identification number for the data transfer application.
5. (Original) The method of claim 1 wherein the authentication mechanism comprises comparing a biometric sample supplied by the user with a biometric template associated with the data transfer application.
6. (Original) The method of claim 5 wherein the biometric sample comprises one or more of the following:

- a fingerprint;
- a facial scan;
- a retinal image;
- an iris scan; and
- a voice print.

7. (Original) The method of claim 1 wherein the authentication mechanism comprises comparing a signature supplied by the user with a signature template associated with the data transfer application.

8. (Original) The method of claim 7 wherein the signature supplied by the user is electronically compared to the signature template.

9. (Original) The method of claim 1, further comprising:
if the authentication mechanism is not satisfied, prompting the user to re-attempt authentication up to a predetermined number of times.

10. (Original) The method of claim 9, further comprising:
prohibiting access to the selected data transfer application when the authentication mechanism has failed a predetermined number of times.

11. (Original) The method of claim 1 further comprising:
transmitting first transaction information from the mobile electronic device to a second device, wherein the first transaction information comprises data uniquely associated with the selected data transfer application; and
receiving at the mobile electronic device second transaction information wherein the second transaction information is provided to the selected data transfer application to complete processing of a data transfer and further wherein the second transaction information is received from the second device.

12. (Original) The method of claim 11 wherein transmitting the first transaction information occurs over a wireless interface.

13. (Original) The method of claim 11 wherein the second transaction information is received over a wireless interface.

14. (Original) The method of claim 1 wherein the identifier is a user-specified nickname for the data transfer application.

15. (Original) The method of claim 1 wherein displaying an identifier for the one or more registered data transfer applications comprises displaying only identifiers for representations of one or more data transfer applications associated with transactions of a user-specified type.

16. (Original) The method of claim 15 wherein available user-specified transaction types comprise one or more of the following:

- credit card transactions;
- debit card transactions;
- calling card transactions;
- stored value transactions;
- loyalty card transactions; and
- coupon transactions.

17. (Currently Amended) The method of claim 1 wherein the mobile electronic device comprises one or more of the following:

- a cellular phone;
- a removable memory card;
- a subscriber information module;
- a personal digital assistant;
- a pager;
- a walkie-talkie;
- an integrated circuit card;

a cellular phone in communication with a subscriber interaction module
a cellular phone in communication with a removable memory card;
a personal digital assistant in communication with a subscriber information module; and
a personal digital assistant in communication with a removable memory card.

18. (Previously Presented) The method of claim 1 further comprising registering one or more data transfer applications for use by the user.

19. (Previously Presented) The method of claim 18 wherein registering the one or more data transfer applications comprises, for each data transfer application:

prompting the user to enter the identifier for the data transfer application; and
storing the user-entered identifier in memory on the mobile electronic device.

20. (Original) The method of claim 19, further comprising:

prompting the user to enter authentication data to be used by the authentication mechanism to authenticate the user in subsequent uses of the data transfer application; and
storing the authentication data in memory on the mobile electronic device.

21. (Previously Presented) The method of claim 18 wherein the step of registering one or more data transfer applications is performed by a service provider for each application.

22. (Original) The method of claim 18 wherein the step of registering one or more data transfer applications is performed by a provider of the mobile electronic device.

23. (Original) The method of claim 1 wherein the disabling step occurs following completion of processing by the enabled data transfer application.

24. (Original) The method of claim 1 wherein the disabling step occurs upon a user-initiated action.

25. (Original) The method of claim 1 wherein the disabling step occurs when the data transfer application has not completed processing within a predetermined time period.

26. (Currently Amended) A method for conducting a data transfer transaction, the method comprising:

receiving a selection for a data transfer application from one or more data transfer applications on a mobile electronic device;

enabling the selected data transfer application when the user satisfies an authentication mechanism ~~associated with~~ that is independent of the selected data transfer application;

processing a transaction using the selected data transfer application, wherein the transaction does not require an additional user authentication; and

disabling the selected data transfer application.

27. (Cancelled)

28. (Original) The method of claim 26 wherein the authentication mechanism comprises entry by the user of a first authentication code which is compared to a second authentication code for the data transfer application.

29. (Original) The method of claim 26 wherein the authentication mechanism comprises the entry of a first personal identification number which is compared to a second personal identification number for the data transfer application.

30. (Original) The method of claim 26 wherein the authentication mechanism comprises comparing a biometric sample supplied by the user with a biometric template associated with the data transfer application.

31. (Original) The method of claim 30 wherein the biometric sample comprises one or more of the following:

a fingerprint;

a facial scan;

a retinal image;
an iris scan; and
a voice print.

32. (Original) The method of claim 26 wherein the authentication mechanism comprises comparing a signature supplied by the user with a signature template associated with the data transfer application.

33. (Original) The method of claim 32 wherein the signature supplied by the user is electronically compared to the signature template.

34. (Original) The method of claim 26, further comprising:
if the authentication mechanism is not satisfied, prompting the user to re-attempt authentication up to a predetermined number of times.

35. (Original) The method of claim 34, further comprising:
prohibiting access to the selected data transfer application when the authentication mechanism has failed a predetermined number of times.

36. (Original) The method of claim 26 wherein processing the transaction comprises:
transmitting first transaction information from the mobile electronic device to a second device, wherein the first transaction information comprises data uniquely associated with the selected data transfer application; and

receiving at the mobile electronic device second transaction information wherein the second transaction information is provided to the selected data transfer application to complete processing of a data transfer and further wherein the second transaction information is received from the second device.

37. (Original) The method of claim 36 wherein transmitting first transaction information comprises transmitting the first transaction information over a wireless interface.

38. (Original) The method of claim 36 wherein receiving second transaction information comprises receiving the second transaction information over a wireless interface.

39. (Original) The method of claim 26 wherein the transaction comprises one or more of the following:

- a credit card transaction;
- a debit card transaction;
- a calling card transaction;
- a stored value transaction;
- a loyalty card transaction; and
- a coupon transaction.

40. (Currently Amended) The method of claim 26 wherein the mobile electronic device comprises one or more of the following:

- a cellular phone;
- a removable memory card;
- a subscriber information module;
- a personal digital assistant;
- a pager;
- a walkie-talkie;
- an integrated circuit ~~card~~ card;
- a cellular phone in communication with a subscriber interaction module
- a cellular phone in communication with a removable memory card;
- a personal digital assistant in communication with a subscriber information module; and
- a personal digital assistant in communication with a removable memory card.

41. (Withdrawn) A method of deploying an application on a mobile electronic device, the method comprising:

- uploading the application to the mobile electronic device;
- receiving, from a user of the mobile electronic device, first authentication data;

receiving, from the user, an identifier for the application; and
storing the first authentication data and the identifier on the mobile electronic device,
wherein the application may be selected by providing the identifier to the mobile electronic
device and further wherein the application will be enabled for use when the user enters second
authentication data which is substantially similar to the first authentication data.

42. (Withdrawn) The method of claim 41 wherein the first authentication data comprises one
or more of the following;

- an authentication code;
- biometric information; and
- a signature.

43. (Withdrawn) A method of registering an application on a mobile electronic device, the
method comprising:

- uploading the application to the mobile electronic device;
- uploading first authentication data to the mobile electronic device, wherein the
authentication data corresponds to the application;
- generating a flag for the application, wherein the flag is set to a value designating an
unregistered state;
- receiving, from a user of the mobile electronic device, second authentication data; and
- if the first authentication data is substantially similar to the second authentication data,
setting the flag to a value designating a registered state.

44. (Currently Amended) A mobile device for managing a plurality of data transfer
applications, the device comprising:

- a processor;
- a display operably connected to the processor;
- at least one input device operably connected to the processor; and
- a computer-readable storage medium operably connected to the processor, wherein the
computer-readable storage medium contains one or more programming instructions for

performing a method of managing the one or more data transfer applications, the method comprising:

- disabling all of the data transfer applications on the device;
- displaying an identifier for at least one of the data transfer applications on the electronic device;
- receiving, from a user, a selection of one of the data transfer applications; and
- enabling the selected data transfer application when the user satisfies an authentication mechanism associated with that is independent of the selected data transfer application.

45. (Cancelled)

46. (Original) The device of claim 44 wherein the authentication mechanism comprises entry by the user of a first authentication code which is compared to a second authentication code for the data transfer application.

47. (Original) The device of claim 44 wherein the authentication mechanism comprises the entry of a first personal identification number, which is compared to a second personal identification number for the data transfer application.

48. (Original) The device of claim 44 wherein the authentication mechanism comprises comparing a biometric sample supplied by the user with a biometric template associated with the data transfer application.

49. (Original) The device of claim 48 wherein the biometric sample comprises one or more of the following:

- a fingerprint;
- a facial scan;
- a retinal image;
- an iris scan; and
- a voice print.

50. (Original) The device of claim 44 wherein the authentication mechanism comprises comparing a signature supplied by the user with a signature template associated with the data transfer application.

51. (Original) The device of claim 50 wherein the signature supplied by the user is electronically compared to the signature template.

52. (Currently Amended) A system for conducting an exchange of data, the system comprising:

- a processor;

- a display operably connected to the processor;

- at least one input device operably connected to the processor;

- a communications interface operably connected to the processor; and

- a computer-readable storage medium operably connected to the processor, wherein the computer-readable storage medium contains one or more programming instructions for performing a method of conducting the exchange of data, the method comprising:

 - selecting a data transfer application from one or more data transfer applications stored on the computer-readable storage medium;

 - enabling the selected data transfer application when a user satisfies an authenticated mechanism associated with that is independent of the selected data transfer application;

 - processing a data transfer transaction using the selected data transfer application, wherein the data transfer transaction does not require additional user authentication; and

 - disabling the selected data transfer application.

53. (Original) The system of claim 52 wherein the communications interface comprises a wireless interface.

54. (Cancelled)

55. (Original) The system of claim 52 wherein the authentication mechanism comprises entry by the user of a first authentication code which is compared to a second authentication code associated with the data transfer application.

56. (Original) The system of claim 52 wherein the authentication mechanism comprises the entry of a first personal identification number which is compared to a second personal identification number for the data transfer application.

57. (Original) The system of claim 52 wherein the authentication mechanism comprises comparing a biometric sample supplied by the user with a biometric template associated with the data transfer application.

58. (Original) The system of claim 57 wherein the biometric sample comprises one or more of the following:

- a fingerprint;
- a facial scan;
- a retinal image;
- an iris scan; and
- a voice print.

59. (Original) The system of claim 52 wherein the authentication mechanism comprises comparing a signature supplied by the user with a signature template associated with the data transfer application.

60. (Original) The system of claim 59 wherein the signature supplied by the user is electronically compared to the signature template.

REMARKS

In the Office Action, claims 1-40 and 44-60 were rejected. More specifically,

- Claims 1, 3-6, 11-14, 17-18 and 21-24 were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent 5,578,808 (Taylor) in view of U.S. Patent 5,541,985 (Ishii);
- Claim 2 was rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of U.S. Patent 6,659,345 (Sukeda);
- Claims 7 and 8 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of U.S. Patent 5,892,824 (Beatson);
- Claims 9-10 and 25 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of U.S. Patent 6,257,486 (Teicher);
- Claims 15 and 16 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of U.S. Patent 6,776,332 (Allen);
- Claims 19 and 20 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of U.S. Patent 6,411,822 (Kraft);
- Claims 26, 28-31 and 36-40 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii;
- Claim 27 was rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of Sukeda;
- Claims 32 and 33 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of Beatson;
- Claims 34 and 35 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of Teicher;
- Claims 44, 46-49, 52-53 and 55-58 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii;
- Claims 45 and 54 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of Sukeda; and
- Claims 50-51 and 59-60 were rejected under 35 U.S.C. §103(a) as being obvious over Taylor in view of Ishii and further in view of Beatson.

By this Amendment, claims 1, 17, 26, 40, 44 and 52 have been amended and claims 2, 27, 45 and 54 have been canceled. Claims 1, 26, 44 and 52 have been amended to include the limitations of old claims 2, 27, 45 and 54, respectively. Claims 17 and 40 have been amended to correct minor typographical errors. Therefore, upon entry of this Response, claims 1, 3-26, 28-40, 44, 46-53 and 55-60 are pending. For the reasons set forth hereinbelow, Applicants respectfully request that the rejections associated with the pending claims be withdrawn.

Claims 1 and 3-25

Applicants have herein amended independent claim 1 to include the limitations of canceled claim 2.

First, Applicants submit that claim 1 is nonobvious over Taylor in view of Ishii (and in further view of Sukeda) because the cited references, either alone or in combination, fail to teach or suggest each and every limitation of claim 1. See MPEP §2143 (stating that one of the elements of a *prima facie* case of obviousness under §103(a) is that the prior art references must teach or suggest all the claim limitations). More particularly, Applicants submit that the combination of Taylor, Ishii and Sukeda fail to teach or suggest, among other things, “enabling the selected data transfer application for use by the user when the user satisfies an authentication mechanism that is **independent** of the selected data transfer application” as recited in claim 1.

Applicants submit that the authorization process taught by Taylor requires the submission of a first authorization code to enable access to the applications on the card (See Taylor, Figure 5, steps 144 and 146) and the submission of a second authorization code when an application is selected (See Taylor, Figure 7, steps 196 and 198). Thus, Applicants submit that the authorization process taught by Taylor is **dependent** upon – **not independent of** – the selected data transfer application as recited in claim 1.

Applicants also submit that Ishii fails to remedy the defects of Taylor with respect to claim 1. Applicants agree with the Examiner’s determination that the combination of Taylor and Ishii fails to teach or suggest, among other things, “enabling a selected data transfer application for use by the user when the user satisfies an authentication mechanism that is **independent** of the selected data transfer application” as recited in claim 1.

Applicants further submit that Sukeda fails to teach or suggest “enabling a selected data transfer application for use by the user when the user satisfies an authentication mechanism that

is **independent** of the selected data transfer application” as recited in claim 1. Sukeda is cited as teaching a smart card (110) comprising a processor for rights to play (213) for authenticating the right of play (222 and 222') for executing application or module independently. However, Applicants submit that the authentication mechanism taught by Sukeda is performed on a game by game basis. Thus, Applicants submit that the authorization process taught by Sukeda is **dependent** upon -- **not independent of** - the selected data transfer application as recited in claim 1.

Therefore, for the reasons set forth hereinabove, Applicants submit that claim 1 is nonobvious over the combination of Taylor, Ishii and Sukeda because the cited references, either alone or in combination, fail to teach or suggest each and every limitation of claim 1. See MPEP §2143 *id.* Applicants further submit that claims 3-25, which depend from claim 1, are also nonobvious over the cited references. See MPEP §2143.03 (stating that if an independent claim is nonobvious under §103(a), then any claim depending therefrom is nonobvious).

Second, Applicants submit that claim 1 is nonobvious over Taylor in view of Ishii (and in further view of Sukeda) because the cited references fail to provide the suggestion or motivation to modify Taylor to realize the invention recited in claim 1. See MPEP §2143 (stating that one of the elements of a prima facie case of obviousness under §103(a) is that there must be some suggestion or motivation to modify the reference or to combine reference teachings).

The Examiner has determined that it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Sukeda to the teachings of the combination of Taylor and Ishii. Applicants respectfully disagree with this determination and note that there is no suggestion or motivation to make the proposed modification if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. See MPEP § 2143.01.

Applicants submit that modifying the combination of the multi-application data card of Taylor and the cellular phone of Ishii with the gaming application of Sukeda would render the cellular phone unsatisfactory for its intended purpose. Ishii checks whether the inserted IC card is a credit card or a prepaid card. See Ishii, col. 6, ll. 3-8. If the data on the IC card is abnormal, an message stating such abnormality is indicated. See *id.*, col. 4, ll. 24-27. In other words, if the IC card inserted into the cellular phone of Ishii is not one of a credit card or a prepaid card, an

abnormal operation is indicated. Sukeda does not teach a credit card or a prepaid card, but a data card for playing gaming applications. As such, the combination of Taylor, Ishii and Sukeda would result in an inoperative system. Therefore, Applicants submit that claim 1 is nonobvious over the cited references, and further submit that claims 3-25, which depend from claim 1, are also nonobvious over the cited references. See MPEP §2143.03.

Accordingly, for the reasons set forth hereinabove, Applicants request that the §103(a) rejections associated with claims 1 and 3-25 be withdrawn.

Claims 26 and 28-40

Applicants have herein amended independent claim 26 to include the limitations of canceled claim 27. Therefore, claim 26 has been amended in a manner similar to that of claim 1.

Accordingly, for reasons similar to those set forth hereinabove with respect to claims 1 and 3-25, Applicants submit that claims 26 and 28-40 are nonobvious over the references of record and request that the §103(a) rejections associated with claims 26 and 28-40 be withdrawn.

Claims 44 and 46-51

Applicants have herein amended independent claim 44 to include the limitations of canceled claim 45. Therefore, claim 44 has been amended in a manner similar to that of claim 1.

Accordingly, for reasons similar to those set forth hereinabove with respect to claims 1 and 3-25, Applicants submit that claims 44 and 46-51 are nonobvious over the references of record and request that the §103(a) rejections associated with claims 44 and 46-51 be withdrawn.

Claims 52-53 and 55-60

Applicants have herein amended independent claim 52 to include the limitations of canceled claim 54. Therefore, claim 52 has been amended in a manner analogous to that of claim 1.

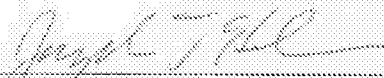
Accordingly, for reasons analogous to those set forth hereinabove with respect to claims 1 and 3-25, Applicants submit that claims 52, 53 and 55-60 are nonobvious over the references of record and request that the §103(a) rejections associated with claims 52, 53 and 55-60 be withdrawn.

CONCLUSION

Applicant respectfully requests a Notice of Allowance for the pending claims in this application. If the Examiner believes that personal communication will expedite the prosecution of this application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

In the event that an additional fee is required for this response, the Commissioner is hereby authorized to charge such fees to Deposit Account No. 50-0436.

Respectfully submitted,
PEPPER HAMILTON LLP



Joseph T. Helmsen
Reg. No. 54,163

Pepper Hamilton LLP
One Mellon Center, 50th Floor
500 Grant Street
Pittsburgh, PA 15219
Telephone: 412.454.5000
Facsimile: 412.281.0717
Date: June 13, 2006